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10/685,626	10/14/2003	Larry G. Kent JR.	190250-1150	5085

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EXAMINER

DENNISON, JERRY B

ART UNIT

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/685,626

**Applicant(s)**

KENT ET AL.

**Examiner**

J. Bret Dennison

**Art Unit**

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 5-12, 20-27 and 38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5-12, 20-27 and 38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### RESPONSE TO AMENDMENT

1. This Action is in response to the Amendment for Application Number 10/685,626 received on 1/29/2008.
2. Claims 5-12, 20-27 and 38 are presented for examination.

#### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claim 38 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
4. Claim 38 includes a system comprising logic. As such, the claim may be interpreted as a software system (i.e. computer program).

Computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs are not physical "things". They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer, which permit the computer program's functionality to be realized.

M.P.E.P. 2601.1 Section I states, "Since a computer program is merely a set of instructions capable of being executed by a computer, the computer program itself is not a process and USPTO personnel should treat a claim for a computer program, without the

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computer-readable medium needed to realize the computer program's functionality, as nonstatutory functional descriptive material."

Claim 38 does not provide the computer-readable medium needed to realize the program's functionality. As such, claim 38 is not limited to statutory subject matter and are therefore non-statutory.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 5-11, 20-26, 38 are rejected under 35 U.S.C. 102(e) as being anticipated by Klassen et al. (US 2005/0066070).
6. Regarding claim 5, Klassen disclosed a communication method comprising:

displaying a first instant messaging (IM) message (Klassen, Fig. 4, message 74 [0042]);

calculating an elapsed time from the displaying of the first IM message (Klassen, [0045], "predetermined duration of time");

determining whether a second IM message has been displayed within the elapsed time (Klassen, [0045]);

displaying a first time indication, the first time indication being associated with the first IM message, the first time indication being displayed in response to determining that the second IM message has not been displayed within the elapsed time, the first time indication displaying a time that the first message was sent (Klassen, Fig. 4, [0045] "a first time stamp 84 is output adjacent the non-responded message").

Claim 20 includes a computer-readable storage medium comprising a processor and a memory configured to store computer-readable code to implement the limitations of claim 5. Claim 38 includes a communication system comprising logic to implement the limitations as described in claim 1. Klassen disclosed a device storing code/logic to perform the limitations as claimed (See Figs. 1 and 2). As such, claims 20 and 38 are rejected under the same rationale as claim 5.

7. Regarding claims 6 and 21, Klassen disclosed the limitations as described in claims 5 and 20, including wherein the step of displaying the first IM message comprises: providing an IM dialogue box within an IM chat window; and displaying the first IM message within the IM dialogue box (Klassen, Fig. 4).

8. Regarding claims 7 and 22, Klassen disclosed the limitations as described in claims 6 and 21, including wherein displaying the first time indication comprises: displaying the first time indication in the IM dialogue box (Klassen, Fig. 4, time stamp 84).

9. Regarding claims 8 and 23, Klassen disclosed the limitations as described in claims 5 and 20, including wherein displaying the first time indication comprises: displaying a first visual delineator after the first IM message, the first visual delineator having a time associated with the first IM message (Klassen, Fig. 4, time stamp 84).

10. Regarding claims 9 and 24, Klassen disclosed the limitations as described in claims 5 and 20, including displaying a second IM message after the elapsed time; displaying a second time indication, the second time indication being associated with the second IM message, the second time indication being indicative of the elapsed time between the first IM message and the second IM message (Klassen, Fig. 4, 47, "second time stamp 92 is output adjacent the resumption message. A user thus can determine from the output on the display 50 the period of time during which the conversation was suspended").

11. Regarding claims 10 and 25, Klassen disclosed the limitations as described in claims 9 and 24, including wherein displaying the second time indication comprises:

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displaying a second visual delineator before the second IM message, the second visual delineator having a time associated with the second IM message (Klassen, [0045], last the lines, see also Fig. 8b).

12. Regarding claims 11 and 26, Klassen disclosed the limitations as described in claims 10 and 25, including wherein displaying the second visual delineator comprises: providing an IM dialogue box within an IM chat window; and displaying the second visual delineator in the IM dialogue box (Klassen, Fig. 8b, 292).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 12 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klassen et al. (US 2005/0066070) in view of Applicant's Admitted Prior Art ("AAPA"), specifically in view of the prior art instant messaging systems presented in the Background section of Applicant's Specification.

The Applicant described instant messaging systems with reference to Figures 1 and 2, which are provided as prior art figures. Therefore, the description provided in the background section in reference to these Figures are construed by the Examiner to constitute an admission of prior art and any subject matter associated with these

descriptions are construed to be prior art applicable to the claims. See MPEP 2129 and *Riverwood Int'l Corp. v. R.A. Jones & Co.*, 324 F.3d 1346, 1354, 66 USPQ2d 1331, 1337 (Fed Cir. 2003).

14. Regarding claims 12 and 27, Klassen disclosed the limitations as described in claims 11 and 26, including selectively displaying a most-recently-displayed IM time in the IM dialogue box, the most-recently-displayed IM time being associated with the most-recently-displayed IM message (Fig. 4, 84).

Klassen did not explicitly state providing a status area within the IM chat window, the status area being distinct from the IM dialogue box.

However, AAPA shows areas above and below item 205 (see AAPA, Fig. 2). Therefore, AAPA shows that it was well known in the art at the time the invention was made that instant messaging chat windows include status windows.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include a status window in the instant messaging chat boxes of Klassen in order to provide users with the status of a message before sending the message to its recipient, or provide extra information regarding the message, thereby providing extra features to the instant messaging system of Klassen making the system more desirable to use by its customers.

#### **Response to Amendment**



Applicant's arguments and amendments filed on 1/29/2008 have been carefully considered but they are not deemed fully persuasive. Applicant's arguments are deemed moot in view of the following new grounds of rejection, necessitated by Applicant's substantial amendment (i.e., *by incorporating new limitations into the independent claims, which required further search and consideration*) to the claims which significantly affected the scope thereof.

It is the Examiner's position that Applicant has not yet submitted claims drawn to limitations, which define the operation and apparatus of Applicant's disclosed invention in manner, which distinguishes over the prior art.

Failure for Applicant to significantly narrow definition/scope of the claims and supply arguments commensurate in scope with the claims implies the Applicant intends broad interpretation be given to the claims. The Examiner has interpreted the claims with scope parallel to the Applicant in the response and reiterates the need for the Applicant to more clearly and distinctly define the claimed invention.

### ***Conclusion***

**Examiner's Note:** Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part

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of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Bret Dennison whose telephone number is (571) 272-3910. The examiner can normally be reached on M-F 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached on (571) 272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/J. Bret Dennison/

Examiner, Art Unit 2143

